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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,609	10/19/2005	Brian Augustine Boserio	Fisher-G	7133

7590 08/09/2007  
David P Dureska  
Buckingham Doolittle & Burroughs  
4518 Fulton Drive NW  
PO Box 35548  
Canton, OH 44735-5548

EXAMINER
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HARTMANN, GARY S

ART UNIT	PAPER NUMBER
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3671

MAIL DATE	DELIVERY MODE
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08/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/530,609

Applicant(s)

BOSERIO, BRIAN AUGUSTINE

Examiner

Gary Hartmann

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 12-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 18-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/16/7.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

The title of the invention is objected to because it refers to the non-elected claims. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Tile Having a Backing Layer and Method of Installation Thereof.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3, 5 and 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 2 and 3, the phrase "respective edges" is indefinite because it lacks antecedent basis and this makes the scope of the claim unclear.

The term "spigot-like" in claim 5 is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The shape of the projection is unclear.

Process claim 18 depends from product claim 1. Claim 1 is directed to a single tile, while claim 18 recites a plurality of tiles. It appears that claim 18 is reciting a configuration disclosed

in claim 1; however, as discussed in the rejections below, this configuration cannot be given patentable weight because the claimed invention is only a single tile and not an arrangement of tiles. Therefore, the dependency of claim 18 must be written such that it clear that it is a tile of claim 1 that is used in the method.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 11, 21 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Karanikas (U.S. Patent Des. 379,670).

Karanikas discloses stone elements bonded to and extending above a base (Figures 2, 4 and 6). The elements are of differing shape and size. Regarding the manner in which a tile may be in relationship to an adjacent tile is outside of the scope of the single tile. In other words, the apparatus is a single tile; therefore, patentable weight cannot be extended to what configuration may or may not exist beyond this solitary product in use.

Regarding claims 2 and 3, at least part of the base extends beyond the outer stone elements. It also appears that the entire base is wider than the stone elements. Note the 112 2<sup>nd</sup> rejection regarding these claims as discussed above.

While not objected to, it is noted that claim 4 recites essentially nothing, since the base can be of any shape. Clearly, the shape of the prior art is "suitable."

While the material is not disclosed, the thickness of the base alone is sufficient to fall within the broadly recited phrase of reinforcing material.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7, 9-11 and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lucas (U.S. Patent 5,470,623).

Lucas discloses stone elements (Figures 1-3) bonded to and extending above a backing layer (2). The elements are of different size but the shapes are the same; however, the examiner takes official notice that it is well known to use different shaped stones in order to obtain a desired appearance. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted at least some of the squares of Lucas with other shapes. Regarding the manner in which a tile may be in relationship to an adjacent tile is outside of the scope of the single tile. In other words, the apparatus is a single tile; therefore, patentable weight cannot be extended to what configuration may or may not exist beyond this solitary product in use.

Regarding claims 2 and 3, the backing layer extends beyond some of the edges of the stone elements. This is all that is needed to meet claim recitations. Also note the 112 2<sup>nd</sup> rejection, above.

Regarding claim 5, a projection and recess is a common means of connection. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used this means of connection in order to facilitate connection between adjacent devices, as deemed suitable in a particular application.

The backing material is a flexible plastic mesh. This meets the recitations of claims 7-10 and 21-23.

Regarding method claims 18-20, Lucas does not discuss installation of the tiles; thereby leaving that step to one skilled in the art.

Regarding claim 18, because it is standard practice to use a grouting composition in tile installation, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a grouting composition with Lucas in order to obtain a durable finished surface.

Regarding claims 19 and 20, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have positioned the tiles adjacent one another in the manner claimed in order to finish a surface of greater than a single tile dimension.

Claims 5-9, 18-20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karanikas, as applied above.

Regarding claim 5, a projection and recess is a common means of connection. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used this means of connection in order to facilitate connection between adjacent devices, as deemed suitable in a particular application.

Because it is a design patent, Karanikas is silent with respect to materials of construction; thereby leaving the decision to one skilled in the art. The examiner takes official notice that the claimed materials are well known. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the materials of any of claims 7-9 and 23 in order to obtain a product suitable for use in a particular application.

Regarding method claims 18-20, Karanikas does not discuss installation of the tiles; thereby leaving that step to one skilled in the art.

Regarding claim 18, because it is standard practice to use a grouting composition in tile installation, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a grouting composition with Karanikas in order to obtain a durable finished surface.

Regarding claims 19 and 20, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have positioned the tiles adjacent one another in the manner claimed in order to finish a surface of greater than a single tile dimension.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Karanikas or Lucas as applied above, and further in view of Brown (U.S. Patent 6.643.667).

Brown teaches optionally including a base which extends beyond a decorative surface (Figure 5) to be useful in some applications. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have extended the base of either Karanikas or Lucas as deemed best suited for a particular application.

***Response to Arguments***

Applicant's arguments filed 4 June 2007 have been considered but are moot in view of the new grounds of rejection.

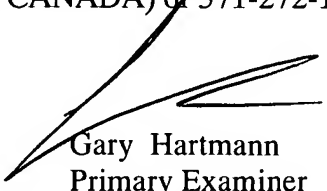
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Hartmann whose telephone number is 571-272-6989. The examiner can normally be reached on Tuesday through Friday, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached on 571-272-6998. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

gh



Gary Hartmann  
Primary Examiner  
Art Unit 3671